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EXAMINER
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FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/973,303

Applicant(s)

OGASAWARA, NOBUO

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1,3-9 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 34-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. Applicants' amendment filed July 27, 2004 is acknowledged. Accordingly, claims 1, 3-9, and 34-40 remain pending.
2. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.

### ***Claim Rejections - 35 USC §103***

3. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-9, and 34-40, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Swartz et. al. (U.S. 5,923,735) ("Swartz") in view of Sone (U.S. 6,204,763). Swartz discloses a means for determining shelf-life information for items (displaying it on a computer monitor); means for recording shelf-life information and a data store (an ordinary computer hard drive or barcode); means accessible to a POS terminal (74) for reading recorded information and a scanner (a first barcode scanner at the hospital pharmacy) attached to a first terminal; means for electronically recording the shelf-life information (a barcode) and an IC card (customer card); a touchscreen unit; means for storing electronic shelf-life information (a computer keyboard); means for formatting (the video driver in the computer);

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means for displaying as an on-screen display (a computer monitor); shelf-life limitation information includes a period for which the product remains viable (inherent in all shelf-lives); and an electronic receipt (the record of customer purchases downloaded from the store sever); a processor coupled to the means for retrieving (with the CPU), the processor adding shelf-life information to the inventory list of products. Swartz does not directly disclose the processor detecting an expired product based upon the shelf-life limitation information and removing the expired product from the inventory files. However, it is the Examiner's factual determination that supermarkets store shelf life information and/or expiration date information in their computerized database(s) for various reasons including but not limited to the prevention of selling expired products. See *e.g.* Berner (U.S. 4,423,486) and Saitou et. al. (U.S. 5,126,935) for examples of how the expiration date may be used in consumer sales.

Sone teaches using this information with a processor detecting an expired product based upon the shelf-life limitation information and removing the expired product from the inventory list. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Swartz as taught by Sone to include detecting an expired product based upon the shelf-life limitation information and removing the expired product from the inventory list. Such a modification would have resulted in better inventory management by alerting the customer to purchase additional product (e.g. milk) if the product's expiration date was reached at home.

5. Claims 1, 3-9, and 34-40, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Swartz in view of Rivalto (U.S. 5,482,139).

Swartz discloses and does not disclosed as noted above. Rivalto teaches removing dates and/or

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perishable goods from the inventory by knowing precisely when the particular expiration dates will occur.

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Swartz as taught by Rivalto to include detecting an expired product based upon the shelf-life limitation information and removing the expired product from the inventory list. Such a modification would have helped the user implement e.g. the process in Rosenweig et. al. (U.S. 6,188,991 B1) ("Rosenweig") where the user could determine which recipes could be made from the user's inventory. By removing this an expired product from inventory, it would be as if the product didn't exist allowing the user to prepare more healthier foods. See e.g. Murrah (U.S. 5,691,684) and Reber et. al. (U.S. 5,798,694) for an exemplary device removing products from inventory using bar codes or radio frequency ("RF") devices.

6. Claims 1, 3-9, and 34-40, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Howard et. al. (U.S. 6,513,017 B1) ("Howard"). Howard discloses the claimed invention but does not directly disclose a receipt. It is the Examiner's position that customer receipts or customer logs are inherent virtually all consumer transactions. In fact, using the grocery clearing house in Howard would require the use of receipts to track sales.

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Howard to expressly disclose providing a receipt. Such a modification would have disclosed an industry standard procedure of providing receipts to customers.

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7. It is the Examiner's factual determination that storing grocery order lists in handheld devices prior to shopping is old and well known in the art. See *e.g.* Green et. al. (U.S. 5,664,110)'s discussion of several user selectable order lists; Tracey et. al. (U.S. 5,979,757) where customer shopping lists can be uploaded directly via a web page or emailed to the vendor; and Nambudiri et. al. (U.S. 6,640,214 B1)'s discussion of multiple shopping lists for each and every vendor; and Bianco (U.S. 5,047,614)'s use of shopping lists and bar codes.
8. It is the Examiner's factual determination that receipts, transaction logs, or purchase history logs are old and well known in the art. See *e.g.* Matsumori (U.S. 6,246,998 B1)'s transaction log file; Tracey et. al. (U.S. 5,979,757)'s discussion of prior purchase records.
9. Regarding bar codes, it is the Examiner factual determination that to one of ordinary skill in this art, it is old and well known that bar codes (*e.g.* UPC bar codes) may contain useful information including but not limited to: date of manufacture; shelf life; place of manufacture; intended distribution route; batch number; government specs; size, weight, color, etc.; safety, health, ingredients, precautions, dosages, etc.; information, pricing, discount, commission, tax, and other accounting information; automatic reordering instructions; serial numbers, and so forth. See *e.g.* Storch et. al. (U.S. 5,548,110).
10. Moreover, it is the Examiner's factual determination that bar code tags and RF tags are art recognized equivalents. See MPEP §2144.06. Both bar code tags and RF tags are used for the same purpose: conveying information about the article to which the tags are attached to a reader machine. Additionally, one of ordinary skill in the art recognizes that the selection of either a bar code tag over an RF tag (or vice versa, RF tag over a bar code tag) is not enough to distinguish the claimed invention over the prior art since both devices are recognized as

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interchangeable depending upon their intended use or the particular environment in which the tag will be used. See MPEP §2144.07. Evidence to support these conclusions includes but is not limited to *Rakers et. al.* (U.S. 6,763,996 B2); *Keys et. al.* (U.S. 6,758,403 B1); *Monico* (U.S. 6,557,758 B1); *McAllister* (U.S. 6,415,978 B1); *Helton et. al.* (U.S. 6,357,662 B1); *Maloney* (U.S. 6,232,876 B1); *Rupport et. al.* (U.S. 5,640,002); *Kewin* (U.S. 5,595,356); *Eberhardt* (U.S. 5,28,784); and *Scribner et. al.* (U.S. 4,688,026).

11. The Examiner concludes that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,<sup>1</sup> the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements<sup>2</sup> with the required clarity, deliberateness, and precision.<sup>3</sup> Third, after receiving express notice in the previous Office Action of the Examiner's

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<sup>1</sup> See the Examiner's previous Office Action mailed April 26, 2004, Paragraph No. 11; the Office Action mailed October 30, 2003, Paragraph No. 16.

<sup>2</sup> "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>3</sup> "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

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position that lexicography is not invoked,<sup>4</sup> Applicants have not pointed out the “supposed errors” in the Examiner’s position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicants have not argued lexicography is invoked). Finally and to be sure of Applicants’ intent, the Examiner also notes that Applicants have declined the Examiner’s express invitation<sup>5</sup> to be their own lexicographer.<sup>6</sup> For due process purposes and except for the application of 112 6<sup>th</sup> paragraph, the Examiner gives notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation . . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>7</sup> The Examiner now

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<sup>4</sup> See again the Examiner’s previous Office Action mailed April 26, 2004, Paragraph No. 11.

<sup>5</sup> *Id.*

<sup>6</sup> The Examiner’s requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner’s requirements were simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed October 31, 2004).

<sup>7</sup> See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification”) (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

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relies heavily and extensively on this interpretation.<sup>8</sup> Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

### *Response to Arguments*

12. Applicant's arguments filed with their amendment have been fully considered but they are not persuasive. Applicants argue that “[n]othing in Swartz indicates that the customer checkout file is later forwarded to a purchasing customer by the store cashier . . . .”<sup>9</sup> The Examiner respectfully disagrees. First, the Examiner notes that the customer takes the portable unit home with them. Additionally, Swartz directly states that the unit holds a “predicted shopping list” based upon “the customer’s historical shopping profile . . . .” Swartz, col. 3, ~lines 31-41.

13. Regarding the storing of shelf life information, the Examiner is relying on Sone for this information.

14. Regarding Rivalto, Applicants arguments are not persuasive. Applicants arguments appear to state that Swartz would not be motivated to make the obvious combination as suggested by the Examiner. While this may or may not be true, the motivation to combine need not be found directly in the primary reference. In fact, the motivation is more frequently found in the prior art. In this case, Sone or Howard provide the motivation to combine.

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<sup>8</sup> See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]”

<sup>9</sup> Applicants’ Remarks Pages 8-9.

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15. Regarding Rosenweig, Applicants again appear to argue a lack of motivation. Again, it is the Examiner's position that the motivation to combine need be expressly stated in the references.

16. Applicants are reminded that there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. See *e.g. In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-1458 (Fed. Cir. 1998); see also *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)(rejecting applicant's argument that the prior art must contain an express suggestion to combine). In fact, where an examiner combines two references in an obviousness rejection, a third reference (which is not expressly stated in the statement of rejection) may be used to provide the motivation to combine. See *e.g. In re Huston*, 308 F.3d 1267, 1278-79, 64 USPQ2d 1801, 1808-09 (Fed. Cir. 2002) (citations and quotations omitted).

17. Applicants' remaining arguments have been considered but are not persuasive.

### ***Conclusion***

18. Applicants' amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. References considered pertinent to Applicants' disclosure are listed on form PTO-892.

20. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8<sup>th</sup> Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

22. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal

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requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

23. It is the Examiner’s factual determination that all limitations in claims 1, 3-9, and 34-40 have been considered and are either disclosed in the references, inherent in the references, or within the knowledge of one of ordinary skill in this art. Furthermore, the disclosure of all claimed elements are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) (“Preponderance of the evidence is the standard that must be met by the PTO in making rejections.” (citations and quotations omitted)). The preceding discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

24. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their “Remarks” (beginning on page 7) traversing the Examiner’s positions on

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various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>10</sup> the Examiner respectfully reminds Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer  
Primary Examiner  
Art Unit 3627

AJF  
October 31, 2004

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<sup>10</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.